

### **REMARKS**

Claims 1-4 and 11-13 remain in the application. Claims 5-10 were previously withdrawn.

In the Office Action mailed on March 23, 2006, the Examiner allowed Claims 2, 3 and 11-13. Applicants thank the Examiner for the allowance of these Claims. Also in the March 23<sup>rd</sup> Office Action, the Examiner rejected Claims 1 and 4 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,809,960 ("the '960 Patent") in view of Prior Art Figure 1 of the Application. The Office Action was designated as final, and Applicants filed a petition to have the finality of the rejection withdrawn on May 23, 2006. The petition was granted, as shown by the communication mailed on June 8, 2006, and therefore, the finality of the rejection in the March 23, 2006 Office Action has been withdrawn.

Applicants have considered the Office Action and have amended Claims 1, 11 and 12 for the purpose of clarity. Based upon the following remarks, Applicants respectfully submit that all of the claims remaining in the application, that is, Claims 1-4 and 11-13, are in condition for allowance.

#### **I. THE REJECTION OF CLAIM 1 UNDER 35 U.S.C. §103 IS NOT PROPER.**

The Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being obvious over the '960 Patent in view of Prior Art Figure 1 of the Application. Specifically, the Examiner stated that the '960 Patent discloses all of the elements of the Claim, except for the material of the spacer disk, which is taught by Prior Art Figure 1 of the Application. Applicants note that it is the burden of the Examiner to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. *See In re Piasecki*, 745 F.2d 1468, 223 U.S.P.Q. 758 (Fed. Cir. 1985). Applicants

respectfully submit that the Examiner has not established a prima facie case of obviousness, as the recited elements of Claim 1 are not taught or even suggested, alone or in combination, by the '960 Patent and Prior Art Figure 1 of the Application. Specifically, Applicants submit that: A. The references do not teach all of the words recited in Claim 1; B. The '960 Patent teaches away from the invention recited in Claim 1 and thus is not a proper reference; C. The '960 Patent and Prior Art Figure 1 of the Application are not able to be properly combined for a valid obviousness rejection; and D. Applicants' previously-filed Affidavit shows that the invention recited in Claim 1 is not obvious.

A. The References Do Not Teach All of the Words Recited in Claim 1.

For an obviousness rejection to be valid, all of the words recited in the rejected claim must be taught by the reference. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In the Office Action, the Examiner stated that the '960 Patent "discloses a suspension assembly of a heavy-duty vehicle axle/suspension system..." (Office Action, at ¶ 2). Applicants respectfully submit that the '960 Patent does not teach a suspension assembly of a heavy-duty vehicle axle/suspension system. Rather, as described in the Field of the Invention at lines 6-8 of column 1, the '960 Patent teaches a bushing assembly for automotive vehicles. Automotive vehicles are not heavy-duty vehicles, as shown by the description provided by Applicants at lines 11-13 of page 1 of the Application, which recites "The invention relates to vehicle axle/suspension systems, and in particular to the suspension assemblies of those systems which are useful for heavy-duty vehicles such as semi-trailers." Therefore, the '960 Patent does not teach a suspension assembly of a heavy-duty vehicle axle/suspension system, as recited in Claim 1.

In addition, the Examiner stated that the '960 Patent discloses "the assembly having a beam" and referred to the upper control arm described at lines 55-56 of column 2 of the '960 Patent for the beam. (Office Action, at ¶ 2 ) At column 2, lines 55-57, the '960 Patent teaches "a joint between an upper control arm in a double wishbone type suspension of an automotive vehicle and a vehicle body". Applicants respectfully submit that the disclosure of an upper control arm in a double wishbone suspension of an automotive vehicle in the '960 Patent does not teach a beam of a suspension assembly of a heavy-duty vehicle axle/suspension system, as recited in Claim 1.

Moreover, the Examiner referred to element number 4 of the '960 Patent for the spacer disk that is recited in Claim 1. However, element number 4 of the '960 Patent is not a spacer disk, but rather an "elastic member". (Col 3, line 55 ) Applicants respectfully submit that the elastic member 4 disclosed by the '960 Patent does not teach the spacer disk recited in Claim 1, as borne out by the structural and functional differences of elastic member 4 and the spacer disk, as will be described in greater detail below.

Since the references do not teach all of the words recited in Claim 1, Applicants respectfully submit that the Claim is not obvious.

B. The '960 Patent Teaches Away from the Invention Recited in Claim 1.

Applicants respectfully submit that the '960 Patent teaches away from the invention recited in Claim 1 and therefore is not a proper reference for an obviousness rejection of the Claim. When the objective of a reference is different than that of the claimed invention, the reference teaches away from the invention and thus does not render the claimed invention obvious. *See In re Haruna*, 249 F.3d 1327, 58 U.S.P.Q.2d 1517 (Fed. Cir. 2001).

The '960 Patent recites that it is directed to reduction of a torsion spring effect of the elastic member, "improving ride-on comfortableness of the vehicle". (Col. 4, ll. 14-19.) In contrast, the objective of Applicants' invention is to reduce wear, as amended Claim 1 expressly recites "whereby excessive wear to the spacer disk generally is prevented." The objective of preventing excessive wear is different from reducing a torsion spring effect of an elastic member and improving ride comfort, showing that the '960 Patent teaches away from the invention recited in Claim 1, and thus is not a proper reference for an obviousness rejection.

The different objectives of the invention recited in Claim 1 and the '960 Patent are borne out by the significant structural differences between them. Applicants now address two of these differences

First, elastic member 4 of the '960 Patent is formed of elastomeric material, as recited at lines 55-56 of column 3, which is a soft. As mentioned above, in the Office Action, the Examiner compares elastic member 4 to the spacer disk recited in Claim 1. However, the spacer disk recited in Claim 1 is formed of a generally rigid polymer, which cooperates with the other features recited in Claim 1 to resist excessive wear, not to improve ride comfort. Such differences between elastic member 4 of the '960 Patent and the spacer disk recited in Claim 1 illustrate the different objectives of the '960 Patent and the Claim, showing that the '960 Patent teaches away from the claimed invention and is therefore not a proper reference.

Second, the side loads experienced by an axle/suspension system of a heavy-duty vehicle are a significant cause of the problem of excessive wear, as recited in the Application at page 3, line 9 through page 4, line 14, which is the problem that Claim 1 reduces or generally prevents. However, as described in the Field of the Invention at lines 6-8 of column 1, the '960 Patent is directed to automobiles, which experience side loads that are of significantly less magnitude than

the side loads experienced by the an axle/suspension system of a heavy-duty vehicle. In addition to experiencing side loads of a lesser magnitude, automotive suspensions such as those disclosed in the '960 Patent employ a control link to handle side loads, while most heavy-duty vehicles do not. As a result, elastic member 4 of the '960 Patent would be too soft and flexible to support the side loads encountered by the axle/suspension system of a heavy-duty vehicle. If subjected to the side loads encountered by a heavy-duty vehicle axle/suspension system, elastic member 4 of the '960 Patent would extrude out from between the bushing assembly and the frame hanger. In contrast, the spacer disk recited in Claim 1, being formed of a generally rigid polymer, distributes the load forces over a larger area, thereby reducing excessive wear. Thus, the significant differences in side load forces encountered by the structures in the '960 Patent and Claim 1, and the way in which they are handled, again show that the '960 Patent teaches away from the claimed invention.

Such differences between the '960 Patent and Claim 1 demonstrate the fact that the '960 Patent teaches away from the Claim and therefore cannot render the claimed invention obvious.

C The '960 Patent and Figure 1 Are Not Able to be Properly Combined.

In the Office Action, since the '960 Patent does not disclose the spacer disk being formed of a generally rigid polymer, as recited in Claim 1, the Examiner combines the '960 Patent with Prior Art Figure 1 of the Application. The Examiner concludes that, since Prior Art Figure 1 of the Application includes a spacer disk of ultrahigh molecular weight polyethylene, Claim 1 is rendered obvious over the '960 Patent in view of Prior Art Figure 1. However, Applicants respectfully submit that the '960 Patent cannot properly be combined with Prior Art Figure 1 of the Application for a valid finding of obviousness, for at least the following two reasons.

1. The '960 Patent is Nonanalogous Art

For a reference to be properly used as a basis of rejection, the reference must either be in the field of the applicant's endeavor, or if not, then be pertinent to the particular problem with which the inventor was concerned. *See In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). If the reference is not in the field or is not pertinent to the problem, it cannot be combined with another reference and used as a basis for an obviousness rejection. *See id.*

As described in detail above, the '960 Patent is in a different field than that of Applicants' invention. That is, the '960 Patent is directed to the automotive industry, while the invention recited in Claim 1 is directed to the heavy-duty vehicle industry, which involves much higher and different loads than the automotive industry, as well as dramatically different structures to handle those loads. In addition, the '960 Patent is directed to the problem of reducing a torsion spring effect of the elastic member and improving ride comfort, which is not pertinent to the problem of excessive wear that is solved by the invention recited in Claim 1. Since the '960 Patent is in a different field from the invention recited in Claim 1, and is not pertinent to the problem solved by the invention recited in Claim 1, Applicants respectfully submit that it may not be combined with another reference for a finding of obviousness, which thereby overcomes the rejection.

2. There Is No Suggestion to Combine the References.

In order for references to be combined to render a claimed invention obvious, there must be a suggestion in the references to combine them. *See In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). As described above, the '960 Patent is directed to reducing a torsion spring effect of the

elastic member and improving ride comfort in the automotive field. In contrast, Prior Art Figure 1 of the Application is directed to reducing excessive wear in the heavy-duty vehicle field, as recited at page 9, line 11 through page 11, line 15 of the Application. Thus, these two references concern entirely different industries, that is, the automobile industry versus the heavy-duty vehicle industry. In addition, they are directed to entirely different objectives: the '960 Patent is directed to reducing a torsion spring effect of the elastic member and improving ride comfort, while Prior Art Figure 1 is directed to reducing excessive wear (although unsuccessfully when compared to the invention recited in Claim 1)

These significant differences between the '960 Patent and Prior Art Figure 1 of the Application show that there is no suggestion in the references to combine them. Without such a suggestion, Applicants respectfully submit that it is improper to combine them for a finding of obviousness.

D Applicants' Previously-Filed Affidavit Shows that Claim 1 Is Not Obvious.

In their Response B, filed on January 25, 2005, Applicants filed a §1.132 Affidavit. That Affidavit shows that Applicants were the first to recognize the advantages of the a spacer disk formed of a generally rigid polymer which generally is prevented from movement relative to the bushing assembly to thereby generally prevent excessive wear to the spacer disk, as recited in Claim 1. The results produced by Applicants' invention have been long-sought after by those skilled in the art, but until Applicants' invention, the results have not been obtained. The Affidavit also unequivocally proves rapid commercial acceptance of Applicants' invention, as well as sustained and increasing commercial acceptance/success. Applicants therefore

respectfully submit that the Affidavit establishes a long-felt need and resultant commercial success, and thereby overcomes the rejection of Claim 1 under 35 U.S.C. § 103(a)

## II. Claim 4 Is Also Allowable

The Examiner also rejected Claim 4 under 35 U.S.C. §103(a) as being obvious over the '960 Patent in view of Prior Art Figure 1 of the Application. Applicants respectfully submit that expressly recited elements of Claim 4 are not taught, alone or in combination, by the '960 Patent and Prior Art Figure 1. Specifically, Claim 4 depends directly from independent Claim 1. Since independent Claim 1 is allowable for the reasons discussed above, Applicants respectfully submit that dependent Claim 4 also is allowable.

## III. CLAIMS 2-3 and 11-13.

### A. Claims 2 and 3.

Applicants thank the Examiner for the allowance of Claims 2 and 3. Since Claims 2 and 3 each depend directly or indirectly from Claim 1, which is believed to be allowable for the reasons discussed above, Applicants respectfully submit that Claims 2 and 3 are allowable without the need to rewrite them.

### B. Claims 11-13.

Applicants thank the Examiner for the allowance of independent Claim 11, independent Claim 12, and Claim 13, which depends from Claim 12. Applicants respectfully submit that the amendments to Claims 11 and 12 are for the purpose of clarity and thus do not affect the allowance of Claims 11-13.



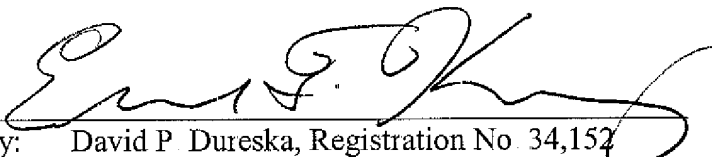
IV. CONCLUSION.

The results produced by Applicants' invention have long been sought after by those skilled in the art, but up until Applicants' invention, the results have been unobtainable. By distinctly reciting new and non-obvious aspects of the invention in independent Claims 1, 11 and 12, it is believed that the rejections based on obviousness have been overcome. Since Claims 2-4 depend from allowable independent Claim 1, and Claim 13 depends from allowable independent Claim 12, Applicants respectfully submit that these Claims also are in condition for allowance.

In view of the above, it is submitted that the claims remaining in the application now are in condition for allowance. Reconsideration of the rejections is respectfully requested and allowance of Claims 1-4 and 11-13 at an early date is hereby respectfully solicited.

Respectfully submitted,

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP

  
By: David P. Dureska, Registration No. 34,152  
Edward T. Kennedy, Registration No. 48,478

4518 Fulton Drive, N.W.  
P.O. Box 35548  
Canton, OH 44735-5548  
Telephone: (330) 491-5289  
Facsimile: (330) 252-5454  
E-Mail: [ddureska@bdblaw.com](mailto:ddureska@bdblaw.com)  
Attorney Docket No.: HEND-AI-REG (45007-144)